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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF APPEALS AND INTERFERENCES

In re Application of: JIN-SU PARK

Appeal No. \_\_\_\_\_

Original Patent: U.S. Patent No. 5,719,618 issued on the 17<sup>th</sup> of February 1998

Serial No.: 09/506,288

Examiner: BUCZINSKI, S.

Filed: 17<sup>th</sup> of February 2000

Art Unit: 3662

For: LOCKING METHOD FOR A SYSTEM WITH AN ON SCREEN DISPLAY  
FUNCTION AND APPARATUS THEREFOR

Attn: Board of Patent Appeals & Interferences

REPLY BRIEF

Commissioner for Patents  
Washington, D.C. 20231

Sir:

Pursuant to Appellant's Notice of Appeal filed on the 9<sup>th</sup> of December 2002, Appellant files this Reply Brief and the accompanying Request for an Oral Hearing before the Board of Patent Appeals and Interferences from the final rejection of claims 20, as set forth in the final Office action mailed on the 9<sup>th</sup> of July 2002 (Paper No. 24) and the Advisory Action mailed on 21<sup>st</sup> of November 2002 (an unnumbered Paper).

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Claims 1 through 19, 21 through 43, and 59 have been allowed as set forth in the final Office action mailed on 9 July 2002 (Paper No. 24) and the Advisory Action mailed on the 21<sup>st</sup> of November 2002 (an unnumbered Paper), and the Examiner's Answer has withdrawn the rejections of all claims other than independent claim 20.

## I. REAL PARTY IN INTEREST

Pursuant to 37 CFR §1.192(c)(1)(as amended), the real party in interest is:

SamSung Electronics Co., Ltd.  
#416, Maetan-dong, Paldal-gu  
Suwon-city, Kyungki-do, Republic of KOREA

as evidenced by the Assignment executed by the inventor on 5 August 1989 and recorded in the U.S. Patent & Trademark Office on 28 August 1989 at Reel 5697, frame 121/122.

## II. RELATED APPEALS AND INTERFERENCES

There are no other appeals and no interferences known to Appellant, Appellant's legal representatives or the assignee which will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

The attention of the Board is invited to Paper No. 35 issued on the 22<sup>nd</sup> of July 1997 in Applicant's Appeal No. 95-1187 based upon the patent application serial no. 08/024,495. In the *Findings of Fact and Conclusion of Law* (Paper No. 35), the Board gave very careful consideration

to then claim 8, which was re-numbered and issued as claim 7 in Applicant's U.S. patent 5,719,618.

### **III. STATUS OF CLAIMS**

Claims 1 through 59 are pending in this reissue application. Claims 1 through 19, 21 through 43, and 59 have been allowed and the rejections of all claims except claim 20, have been withdrawn.

Reissue claim 20 stands finally rejected. Claim 20 is independent.

### **IV. STATUS OF AMENDMENTS**

The Examiner's Answer has confirmed that Appellant's statement of the status of amendments is correct.

### **V. SUMMARY OF INVENTION**

The Examiner's Answer has confirmed that Appellant's Summary of Invention is correct.

## VI. ISSUES

### I. Were Claims 21 and 44 Through 58 Improperly Rejected Under 35 U.S.C. §251?

- A. Does 35 U.S.C. §251 Prohibit The Allowance Of Reissue Claims That Are Broader In Scope Than The Patented Claims?
- B. Does 35 U.S.C. §251 Require That Reissue Claims Which Are Broader In Scope Than The Patent Claims Contain All Of The Constituent Elements Of The Narrowest One of Those Patent Claims, Even Though The Reissue Claims Are Directed To Subject Matter That Is Different From That Defined By The Patent Claims?
- C. Does 35 U.S.C. §251 Prohibit Allowance Of Reissue Claims That Are Patentably Distinguishable Over The Prior Art For Reasons That Are Different From The Reasons For Allowance Of The Patent Claims?
- D. Does 35 U.S.C. §251 Either Invoke An Impermissible "Point-Of-Novelty" Test of Patentability Or Limit The Scope Of Coverage Attainable With A Reissue Claim By Mandating That Each Reissue Claim Include As Limitations One Or More Of The Reasons Articulated By The Board Of Patent Appeals And Interferences For Refusing To Sustain A Final Anticipation Rejection Of A Patent Claim?

### II. Is There Evidence In The Instant Record That Fairly Justifies A Rejection Of Claims 21 And 44 Through 58 Under The Doctrine Of Reissue Recapture?

- D. Did The Examiner Correctly Follow The Procedure Established By The Commissioner Of The United States Patent & Trademark Office For Making A Determination Of An Improper Recapture Under 35 U.S.C. §251?
- E. Where Appellant Correctly Demonstrated That The Prior Art Fails To Teach What An Office Action Represented That Art As Allegedly Teaching, Does Appellant's Demonstration Of Those Omissions In The Art Thereafter Create A Recapture Estoppel That Restricts The Scope Of Reissue Coverage To Only Reissue Claims That Recite Each And Every Item That Was Found Lacking

**In The Prior Art's Teaching?**

- F. Where the Office Action Fails To Make A Finding Of In What Aspects The Reissue Claims Are Broader Than The Patent Claims, And Fails To Provide Evidence That The Broader Aspects Relate To Surrendered Subject Matter, The Rejection Must Be Withdrawn?**
- G. May A Recapture Rejection Under 35 U.S.C. §251 Be Maintained Where The Office Action Fails To Make A Finding Of Which Aspects Of The Reissue Claims Are Broader Than The Patented Claims, And Fails To Provide Evidence That The Broader Aspects Relate To Surrendered Subject Matter?**
- H. Is This Particular Recapture Rejection of Claims 21 And 44 Through 58 Under 35 U.S.C. §251 An Improper, Back-door Attempt To Revive The *Point-of-novelty* Criterion For Patentability?**
- I. Do Alternative Statements Made By An Appellant To Explain The Impropriety Of A Rejection Under 35 U.S.C. §102 Constitute An Amendment Of The Rejected Claim Or Constitute A Surrender Of Patentable Subject Matter Under 35 U.S.C. §251?**
- J. Even Ignoring Arguendo A Lack Of Basis For Imposition Of A Rejection Under 35 U.S.C. §251 And The Doctrine Of Recapture, And A Failure Of The Examiner To Follow The Mandated Procedure Under MPEP §1412.02, Do Claims 21 And 44 Through 58 Each Define At Least One Of The Constituent Aspects Required By The Examiner To Avoid Recapture?**
- K. The Examiner's Assertion That *Not All Features Of The Original Claims Were So Argued, Just That Listed Below As It Relates To The Method Claims Of The Same Reasonable Scope* Is A Non Sequitur That Does Not Support The Examiner's Recapture Rejection Of Claim 20 Under 35 U.S.C. §251.**
- L. 35 U.S.C. §251 And The Doctrine Of Reissue Recapture Do Not Either Seize Upon Any Explanation Given By An Appellant In Support Of The Traversal Of An Art Rejection Or Use The Fact That Appellant Mentioned The Presence Of One Or More Aspects Of A Rejected Claim When Traversing An Art Rejection, As Creating An Insurmountable Bar To Allowance Of A Reissued**

**Claim Which Fails To Recite The Identical Aspect Mentioned In The Appellant's Traversal.**

**VII. GROUPING OF THE CLAIMS**

The Examiner's Answer states that "only claim 20 is now being rejected." Consequently, withdrawal of the "reissue recapture" rejection under 35 U.S.C. §251 of claims 21 and 44 through 58 means that claim 20 stands alone.

**VIII. ARGUMENT**

Appellant raised three (3) issues under the first question, of whether Claim 20 was improperly rejected under 35 U.S.C. §251, and seven (7) separate issue under the second question, of whether there is evidence in the instant record that fairly justifies a rejection of claim 20 under the doctrine of reissue recapture. The Examiner has only superficially addressed the three issues raised by the first question (*i.e.*, issues I.A, I.B and I.C), and has only made a cursory, albeit incomplete presentation of *Pannu v. Storz Instruments*, 59 USPQ2d, 1600 (Fed. Cir. 2001) and *Hester Industries, Inc. v. Stein, Inc.*, 46 USPQ2d 1641 (Fed. Cir. 1998) to address the three of the first four (*i.e.*, issues II.D, II.F and II.G) of the seven issues raised by Appellant's second question; the Examiner has not addressed the facts presented in Appellant's argument and has implicitly conceded the third of the seven issued raised by Appellant's second question (issue II.E). In

addressing the fifth issue raised by Appellant's second question, the Examiner seems to assert that 22<sup>nd</sup> of July 1997 Opinion of the Board in Appellant's patent, created "lesser limitations", even though the single patent claim 7 then before the Board was subsequently issued without amendment. The Examiner appears to properly concede the correctness of Appellant's presentation on the last two issues raised by Appellant's second question (*i.e.*, issues II.J and II.K), and has not made any argument traversing Appellant's issues II.J and II. K.

The Examiner's Answer has raised the following additional issues, which Appellant now addresses.

**I. Claim 20 Was Improperly Rejected Under 35 U.S.C. §251.**

Independent claim 20 stands finally rejected under 35 U.S.C. §251 as being drawn to recaptured subject matter. This rejection is improper for the following reasons in addition to those set forth in Appellant's Appeal Brief.

- D. 35 U.S.C. §251 Neither Invokes An Impermissible "Point-Of-Novelty" Test Of Patentability Nor Limits The Scope of Coverage Attainable With A Reissue Claim By Mandating That Each Reissue Claim Have As Included Limitations One Or More Of The Reasons Articulated By The Board Of Patent Appeals And Interferences For Refusing To Sustain A Final Anticipation Rejection Of A Patent Claim.**

In support of this rejection, the Examiner now asserts that:

"[t]he arguments and limitations presented then must at least now be relied upon to define why the present claim 20 of related scope should be considered allowable

over the same." Examiner's Answer, page 4.

The Examiner's reliance upon the reasoning given by the Board of Patent Appeals & Interferences in refusing to sustain the anticipation rejections of patent claim 8, were previously addressed by Appellant in the remarks of Appellant's amendment filed on the 21<sup>st</sup> of November 2001; the Examiner has now withdrawn the anticipation rejection of claim 20, but has raised the same issue under the guise of reissue recapture to support a rejection under 35 U.S.C. §251.

First, the Examiner's reliance is misplaced and confuses the issue of reissue recapture, because the Examiner has, among other reasons, ignored both the express holdings and the rationale given by the Board for those holdings in the following numbered paragraphs:

- "19. After considering the contested limitations, we do not find a preponderance of evidence supporting a finding of anticipation under 35 U.S.C. §102(b) in view of Bonneau."
- "27. In light of the above findings, the preponderance of evidence does not support a finding of anticipation under 35 U.S.C. §102(b) in view of Amano."
- "13. Thus, we construe 'checking ... during a system power standby mode close inside' (claim 8) to mean running the key-checking function while the main system power is off. Bonneau discloses no equivalent requirement for starting the locking process from a system-power-off state. Thus, Bonneau does not anticipate the claimed invention."
- "14. Bonneau displays two kinds of prompts for entry of a security code: a blank screen (8:22-24) and a blinking screen (7:50-53). Bonneau displays the blank screen during security-code entry so the code cannot be observed. Applicant, however, discloses acts of prompting for each digit of the code independently and of displaying each digit as it is entered. (Paper 1 at 8-11; Fig. 4.) Thus, Bonneau's

U.S. display step is not equivalent to the claimed display step.”

- “16. Bonneau does not, however, have a step equivalent to Applicant’s process of clearing the existing code or setting a new code each time. (Paper 1 at 12-13.) Moreover, since Bonneau does not display the code, it cannot clear the code from the display.”
- “22. Amano has nothing equivalent to Applicant’s claim limitation that the system power be off during the checking step. The system power is on during Amano’s code entry steps. (5:36-45; Fig. 3.)”
- “24. Amano is silent about whether the entered lock code is stored. Nothing in Amano suggests a step equivalent to Applicant’s step of storing a new code if the system is not locked.”

In short, the Board did not engage in an impermissible *point-of-novelty* determination of patentability; the Board considered patent claim 7 in its entirety. Consequently, the Examiner’s resurrection of this issue under a guise of recapture rejection under 35 U.S.C. §251, as opposed to the anticipation rejection to which Applicant’s amendment of the 21<sup>st</sup> of November 2001 was formally addressed, is misplaced.

As was earlier explained, the seminal judicial decision of *Pannu v. Storz Instrument, Inc.*, Fed. Cir. 00-1482, 7/25/2001 (decision) refers to U.S. Patent No. 4,436,855 (the Examiner’s attention is drawn to the fact that the decision of the Court is incorrect, and that the Pannu '855 is actually U.S. Patent No. 4,435,855) and Re32,525. All claims in the '855 patent defined the haptics as having “a continuous, substantially circular arc having a diameter greater than the diameter of the lens body,” while reissue claims 1 through 10 in the '525 reissue patent deleted this limitation.

There were no other independent claims in the '855 Pannu patent; consequently, *all* claims contained the same limitation. In view of the amendments of all claims to add the "two flexible and supporting elements" *and* the accompanying arguments presented by Pannu during prosecution of the '855 patent, the Court properly held that an attempt to obtain a broader definition of the haptics constituted a recapture of subject matter surrendered during the prosecution of the '855 patent.

A similar result may be found in *Hester Industries Inc. v. Stern Inc.*, 64 USPQ2d 1641 (Fed. Cir. 1998) where all of the original claims defined cooking "solely with steam" supplied by "two sources of steam", which limitations were deleted from the reissue patent. There, the Court properly held that the reissue patent was invalid.

In the instant application however, the Examiner has focused upon Applicant's "system power stand-by state" as defined by issued independent method claims 7 and 8, and has asserted that the absence of this limitation from the rejected claims constitutes impermissible recapture. The Examiner has ignored however, the fact that independent method claim 1 defines not the "system power stand-by state" of patent claim 7, but instead defines simply a "stand-by mode of operation" while independent patent apparatus claim 2 defines a "stand-by mode of operation."

The rejected claim 20 also defines a "stand-by mode of operation" as opposed to the "system power stand-by state" of patent claim 7 argued by the Examiner. In view of the fact that patent claims 1 through 6 and 8 were not addressed by the Board of Patent Appeals and

Interferences and were not the subject matter of the arguments presented by Applicant for patentability of patent claim 7, there is no basis for arguing recapture. Neither *Pannu* nor *Hester Industries* dictates a recapture rejection of Applicant's claim 20 because Appellant's rejected claim 20 is directed to different subject matter than Appellant's patent claim 7, while the *Pannu* and *Hester Industries* applicants presented as reissue claims, the patent claims amended to delete the very limitations presented during prosecution to overcome the prior art. In essence, both the *Pannu* and *Hester Industries* reissue applicants presented reissue claims that were directed to the same subject matter as their patent claims, with the reissue claims differing from the patent claims principally by the omission of specific limitations that had served to distinguish their patent claims from the prior art. Neither the *Pannu* nor *Hester Industries* panels of the United States Court of Appeals for the Federal Circuit either held, nor even addressed the issue of whether those reissue applicants were entitled to present reissue claims directed to inventions that were substantively, structurally or operationally different from the inventions defined by their patent claims.

**Second,** the decision of the Board was limited to patent claim 7; rejected claim 20 differs substantially in content, subject matter and definition of Applicant's inventions. As explained in Applicant's remarks filed on the 21<sup>st</sup> of November 2001, the rationale given by the Board for its several holdings in its decision of the 22<sup>nd</sup> of July 1997, does not create some sort of estoppel that forbids Applicant from further presenting any claim that does not contain a verbatim recitation of all of the limitations of patent claim 8. Evidence of this may be gleaned from the fact that issued

patent claims 1-7 were not before the Board, but were in fact allowed by the Examiner prior to the decision of the Board, even though these claims had earlier been rejected as rendered obvious by the same Amano and Bonneau references. Patent claims 1 through 6 and 8 differ in their coverage of different implementations and embodiments of Applicant's invention, differ in the language to define the structural, features and process steps of those inventions, and differ in their definitions of the circuits, or process steps, required to practice the corresponding invention. Claim 20 similarly differs from patent claim 8. The fact that the Board, in its thoroughness while reviewing the final rejection of patent claim 8 gave several reasons for refusing to sustain the final rejection, does not now mandate that reissue process claim 20 recite the same patentably distinguishing features of patent claim 8. It is respectfully suggested therefore, that claim 20 is not similar to process patent claim 8, and that the Board did not have the opportunity when considering patent claim 8 of also considering reissue claim 20.

Moreover, it is the decision of the Board, rather than the reasoning given by the Board in support of its decision, that constitutes the jural fact. Often, the reasoning is simply *obiter dictum*, which itself does not carry legal effect. The Examiner's reliance upon the reasoning given by the Board for its decision is consequently misplaced, and should be withdrawn.

**E. 35 U.S.C. §251 Does Not Require A Reissue Applicant "To Only Correct Errors In The Parent Patent Method Claims."**

The Examiner has newly asserted that “any method claim is required in reissue proceedings under 35 U.S.C. §251 to only correct errors in the parent patent method claims.” Examiner’s Answer, page 4. The Examiner cites *Pannu v. Storz Instruments, Inc.*, 59 USPQ2d at (1600 Fed. Cir. 201) as supporting a reissue Applicant’s presentation of method claims.

Third, The Examiner’s *idee fixe* that the feature of “checking for a key-data input signal from said keyboard or remote control during a system power standby mode” (Examiner’s Answer, page 4) referred to by the Board in paragraph 13 of its 1997 Decision and found in patent claim 7, ignores Appellant’s patent claim 1’s definition of “when ... is in said standby mode of operation, *receiving* a lock function code ... .” Even assuming *arguendo* that the reasoning given by the Board in its 1997 Decision creates a reissue estoppel, reissue claim 20 is, in the particular clause of the Examiner’s *idee fixe*, more comparable to patent claim 1 than to patent claim 7. There is a telling incongruity in the Examiner’s insistence that reissue claim 20 must include patent claim 7’s step of “*checking* ... during a system power standby mode”, while not insisting that reissue claim 20 also include patent claim 1’s step of “*receiving*” during a “standby mode of operation.” The incongruity is easily explained by reading patent claims 1 and 7 and reissue claim 20; this incongruity occurs because patent claims 1 and 7 and reissue claim 20 are each directed to different subject matter. Unlike *Pannu* and *Hester Industries*, where the patent and reissue claims differed only in scope, here Appellant’s reissue claim 20 differ in substantive content, structural aspects and the inter-cooperation between their structural aspects. There is no basis to sustain this rejection

provided by the Examiner's attempt to assert a reissue claim 20 do during their respective standby modes of operation.

Moreover, and most significantly, and unlike the Applicant in Pannu and Hester Industries, Applicant here never argued non-obviousness before the Board of Appeals in the parent application. *See*, for paragraph 8 of the Board's findings, where the Board wrote "Curiously, Applicant does not challenge the examiner's rejection for obviousness in his brief." The Board continued however, by finding that the Examiner simply had not met "the burden of establishing unpatentability by a preponderance of the evidence." Absent challenge by Applicant then, there is no basis for the Examiner to now assert recapture. The rejections for recapture are unfounded on the record, and should not be sustained.

#### Procedure for Determination of Recapture

The Examiner's attention is invited to the reasoning of the Court in the *Pannu* decision, where the Court explains that the application "of the recapture rule is a three step process. The first step is to determine whether and in what aspect the reissue claims are broader than the patent claims. The second step is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter. Finally, the Court must determine whether the reissue claims were materially narrowed in other aspects to avoid the recapture rule. These three steps are set forth in the *Manual of Patent Examining Procedure*, §1412.02 (8<sup>th</sup> ed.).

As explained in the *Manual*,

"If the limitation now being omitted or broadened in the present reissue was originally presented/argued/stated in the original application to make the claims allowable *over a rejection or objection* made in the original application, the omitted limitation relates to subject matter previously surrendered by applicant, and impermissible recapture exists." §1412.02

The Examiner has confused the arguments presented on behalf of patentability of what is now claim 8, with prosecution of what are now claims 1 through 7. Independent method claims 2 and 9 were presented in Applicant's Preliminary Amendment filed on 1 March 1993, together with independent apparatus claims 3 and 5 (now claims 2 and 4). The issues raised by the Examiner about *standby state* were raised by Applicant in an unanswered Petition under 37 C.F.R. §1.181 filed on 12 January 1994 and an unanswered renewed Petition under 37 C.F.R. §1.181 filed on 17 February 1994. It is disingenuous for the Examiner to now raise these issues, when the original Petitions remain unanswered by the Director.

Moreover, independent method claims 2 and 9, which are now patented method claims 1 and 8, were never amended and were never argued as being distinguishable over the art due to the presence of "during said power standby mode". Similarly, independent apparatus claims 3 and 5 (now patented claims 2 and 4) were neither amended nor argued to either include or as distinguished over the art due to the presence of the limitation "during a system power standby state." This limitation was present in originally drafted claim 8 filed on 10 May 1993, and was neither amended to avoid art or to otherwise obtain allowance of claim 8, simply because this

limitation was never amended and it was the Board, rather than the Examiner, who allowed claim 8. Consequently, the first step applied in recapture rule, that is, identifying a limitation that “was originally presented/argued/stated in the original application to make the claims allowable over a rejection made in the original application”, is wholly absent here. MPEP §1412.02.

**Arguments Made During Prosecution**

Furthermore, Applicant has surrendered nothing during the prosecution of the parent application. As explained in §1412.02,

“argument (without amendment to the claims) in the original application may be sufficient to establish recapture.”

Here, Applicant never argued the phrase “during the system power standby state” in conjunction with the allowance of independent apparatus claims 3 and 5 (now claims 2 and 4) simply because that limitation is not present in these apparatus claims. Moreover, Applicant never argued this limitation in conjunction with the allowance of independent method claims 2 and 9 (now claims 1 and 8), as is evident in the Remarks of Applicant's Amendment filed on 30 June 1994. It was the subsequent Office action, and the Advisory Action dated 8 July 1994 that allowed claims 2 through 7 and 9. With exception of one issue under the second paragraph of §112 pertain to claim 3, the Remarks in that Amendment were directed to patentability of claim 8, which was subsequently allowed by the Board. Applicant's unanswered Petitions of the 12 January 1994 and 17 February 1994 dealt with the procedure followed by the Examiner, and presented neither arguments nor

amendments of subsequently allowed claims 2 through 7 and 9. The Examiner's attention is directed to pages 9-11 of Applicant's long unanswered Petition of 17 February 1994, where claims 2 through 7 and 9 were discussed. The word "standby" does not appear anywhere in these discussions. No amendments of these claims were made to add any limitation of "standby". Similar arguments are set forth in pages 8-10 of Applicant's earlier filed, but also long unanswered Petition dated 12 January 1994. In view of the failure and refusal of the Group to timely respond to these Petitions, there is no basis for the Commissioner to now raise those issues. In short, there is neither surrender nor demonstration of the absence of the third step required by the *Pennu* decision, namely, a determination of whether the reissue claims are materially narrowed in other respects so as to avoid the recapture rule. In short, the rejection is incomplete and improper on both the amendments presented during the prosecution of the parent claims and the arguments presented for patentability of those claims.

**Relation Between Patented and Rejected Claims**

The Examiner has argued that claim 20 can only relate to patented claim 7, and method claims 44-58 may only be related to patented claims 7 and 8. The Examiner has no authority to make this assertion, and there is no showing that these claims are not also related to patented apparatus claims 2 and 4.

The Examiner questions whether claim 20 should expressly state that Applicant's step of "making a subjective evaluation" is "being done during said system power standby mode" as

established by claim 7. Claim 7 lacks Applicant step of "making a subjective evaluation". Consequently, claim 7 does not create any estoppel to Applicant's presentation of claims containing process steps that are not present in claim 7. By way of example, nothing in a doctrine of recapture prevents Applicant from amending claim 7, by way of example, to include Applicant's step of "making a subjective evaluation". Consequently, there is nothing in the doctrine that prevents Applicant from presenting claim 20 with this process step.

The Examiner's attention is invited to the fact that claim 20 does define a step of "during said power standby mode of operation, selectively generating a code". Independent claim 1 defines a method in which "when the video cassette recorder is in said standby mode of operation", the recorder receives "a lack function code". Claim 2 defines a recorder having "a standby mode of operation wherein the video tape is not reproduced" while claim 4 defines a recorder having "a standby mode of operation wherein the video tape is not reproduced." Claim 7 alternatively defines a method of "checking" during "a system power standby mode of operation" for "a key-data input signal" while claim 8 defines "checking for an input signal, ... during a system power stand-by state." Nothing in the arguments presented during prosecution, or in limitation added to the claims during prosecution, suggest that Applicant is forbidden from broadly defining an alternative step of "during said system power standby mode of operation, selectively generating a code" as set forth in line 5 of claim 20, in combination with a newly presented step of "making a subjective evaluation", despite the fact that none of the pending claims expressly use this

combination of language. Consequently, there is no basis for refusing allowance of claim 20 simply because Applicant does not expressly define step of making the evaluation during the system power standby mode, when neither the amendments to the claims presented during prosecution of the parent application, or the arguments presented in support of the allowance of those claims, state that the step of "evaluation" occurs "during the system power standby mode of operation." Withdrawal of this rejection of claim 20 is therefore required.

The Examiner questions whether the arguments presented in the Brief in Applicant's parent application in support of patentability of claim 8, require that independent claims 44, 48, 55 and 56 expressly recite either a "standby" mode as defined by claim 1 or a "power standby" as defined by claim 7 and 8? The Examiner asserts that reference to apparatus claim 4 as a basis for this reissue process/method claims can not provide a basis for recapture here. Applicant agrees with the Examiner's assertion. The fact that claims 44 through 58 might be related in various aspects to apparatus claim 4, rather than claim 8 which was ultimately allowed by the Board of Appeals is irrelevant to application of the doctrine of recapture. The Examiner's question ignores the fact that patented claim 7, rather than patented claim 8, with the subject matter of the Brief, and that the arguments presented and supported the patentability of patented claim 7 have nothing to do with the patentability of either patented claims 1 through 6 or patented claim 8. The fact that the "standby" mode may have been argued as a point of patentable distinction of patented claim 7, has nothing to do with patentability of apparatus claims 2 and 4, neither of which define specific

process steps as occurring during a standby mode of operation. Patented claims 1 through 6 and 8 were allowed prior to Applicant's presentation of any arguments or remarks directed to the "standby" mode. Consequently, neither the amendments to patented claims 1 through 6 and 8 nor arguments presented in support of patentability of those claims creates a recapture bar to Applicant's presentation now of reissue process claims that perform certain steps that are not limited to occurrence during a standby mode. This permissible breath of scope according to Applicant's presentation of process claims conforms to the scope of the patented apparatus claims, which do not limit the operation of particular constituent elements to the occurrence of a standby mode. Withdrawal of this rejection is therefore required.

In summary, the foregoing deficiencies in application of the recapture rule, together with the fact that Applicant made no amendment of either patented method claims 1 and 7 or patented apparatus claims 2 and 4 to add any "power standby" limitation, and made no argument to justify patentability of these claims over the applied art, establishes that recapture does not exist. The Examiner is further reminded that claim 7 was the subject of the appeal, and that was the Board, rather than the Examiner who allowed claim 7. Claim 7 however, differs in scope, breadth, and content from these rejected claims, as well as from claims 1, 2, 4 and 8. There is no basis therefore, in restricting the consideration of recapture to only patented claims 7 and 8.

## **II. Is There Evidence In The Instant Record That Fairly Justifies A Rejection Of Claim 20**

**Under The Doctrine Of Reissue Recapture?**

**K. The Examiner's Assertion That Not All Features Of The Original Claims Were So Argued, Just That Listed Below As It Relates To The Method Claims Of The Same Reasonable Scope Is A Non Sequitur That Does Not Support The Examiner's Recapture Rejection Of Claim 20 Under 35 U.S.C. §251.**

On page 5 of the Examiner's Answer, paragraph 10, the Examiner argues that,

"[n]ot all features of the original claims were so argued, just that listed below as it relates to the method claims of the same reasonable scope ... [t]he present rejected claims do not include '*checking for a key-data input signal from said keyboard or remote control during a system power standby mode*' as is required by arguments introduced by Applicant and further supported by the Opinion of the Board of Appeals (mailed 22<sup>nd</sup> of July 1997, page 6, lines 10-14 of the Opinion.'" Examiner's Answer, pages 5.

The Examiner has distorted the prosecution history of Appellant's patent; in its *Findings Of Fact And Conclusions Of Law* issued on the 22<sup>nd</sup> of July 1997, the Board carefully examined seven (7) distinct limitations of patent claim 7 in paragraphs 10 through 18, and six (6) distinct limitations of patent claim 7 and last two paragraphs on page 11 and the first paragraph on page 12 of Appellant's amendment filed on the 1<sup>st</sup> of December 1998. The Board only addressed limitations raised by the Appellant in the Briefs. The distortion is explained in greater detail in conjunction with the following issue; but it suffices to recognize that Appellant argued more than the single feature of patent claim 7 which the Examiner now asserts is the *sine qua non* of the invention defined by reissue claim 20. Additionally, the Examiner has improperly miscast Appellant's claim

20 as being of comparable scope to patent claim 7; patent claim 7 defines a process of *checking for key-data input* during a system standby mode, while reissue process claim 20 is directed to a different invention, with a process step of *generating a code* during a system power standby mode – claims 7 and 20 are directed to different inventions, a fact that seems to be lost upon the Examiner. The *non sequitur*<sup>1</sup> is best demonstrated by the fact that if the feature of claim 1 now argued by the Examiner were absent from claim 7, claim 7 would still probably be allowable over Bonneau because the Board found that “a preponderance of evidence” did not support the rejection. In short, the Board had already noted that “Bonneau’s display step is not equivalent to the claimed display step. That is, the Board had more than one finding of fact to support its *Conclusion of Law*.

**L. 35 U.S.C. §251 And The Doctrine Of Reissue Recapture Do Not Either Seize Upon Any Explanation Given By An Appellant In Support Of The Traversal Of An Art Rejection Or Use The Fact That Appellant Mentioned The Presence Of One Or More Aspects Of A Rejected Claim When Traversing An Art Rejection, As Creating An Insurmountable Bar To Allowance Of A Reissued Claim Which Fails To Recite The Identical Aspect Mentioned In The Appellant’s Traversal.**

In the Examiner’s Answer (paragraph 11), page 4), the Examiner asserts that:

“The few critical elements under *Hester* argued by Applicant as essential to the method claim is the prosecution history : ‘*checking for a key-data input signal from said keyboard or remote control during a system power standby mode*’ as deemed critical by

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<sup>1</sup> Technically, this argument in the Examiner’s Answer is referred to in logic as an *ignoratio elenchi*, that is, a logical fallacy which consists in apparently refuting an opponent while actually disproving some statement different from that advanced by him (OED).

arguments first introduced by Applicant on page 8, lines 4-8 of their Brief, but restricted to only the above language in the Opinion of the Board of Appeals mailed 22 July 1997 (page 6). Examiner's Answer, page 6.

Although the Examiner concedes that the condition precedent for the creation of reissue recapture, mainly amendment of a claim in order to overcome a prior art rejection, did not occur during prosecution of the parent application (because Appellant's *checking* process step was present in patent claim 7 when that claim was first written in the amendment of the 10<sup>th</sup> of May 1993, the Examiner now asserts that the doctrine of reissue recapture prohibits allowance of any reissue claim that does not include all of the "structural features" that an Appellant mentioned in remarks traversing an anticipation rejection because the specific structural features mentioned in those remarks are absent from the rejected reissue claims.<sup>2</sup> Appellant's use of particular phrases referring to structural features of the claim simply buttresses the broad assertion that the Examiner's anticipation rejection based upon Bonneau is wholly unfounded and specious. The Examiner apparently agreed, and withdrew that rejection of apparatus patent claim 8 in the next correspondence. Moreover, the fact that this feature is wholly absent from patent claims 1 though 6 is additional evidence of the speciousness of the Examiner's current position about the criticality of this feature. Furthermore, the fact that Appellant did bring this feature of patent claim 7 to the attention of the Examiner in the Briefs that resulted in the 22<sup>nd</sup> of July 1997 Decision by the Board

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<sup>2</sup> Unlike *Hester Industries*, Appellant made this statement but once, and the Board concurred, and refused to sustain the anticipation rejection of patent claim 7.

is simply customary practice under the Rules.<sup>3</sup> The Examiner's current attempt to create an estoppel from Appellant's compliance with the Rules is not supported by either *Pannu* or *Hester*.

## IX. CONCLUSION

The extreme breadth of the express language of the fourth paragraph of 35 U.S.C. §251 in permitting, in timely filed reissue applications, the prospect of allowance of reissue claims "enlarging the scope of the claims of the original patent", argues against the convoluted reading of *Pannu* and *Hester Industries* now urged by the Examiner. A recognition that 35 U.S.C. §251 does not mandate that reissue claims include all of the features of either a specific one of several diverse patent or one of several features found by the Board to be patentably distinguishing in a patent claim that is directed to different subject matter, and a recognition that 35 U.S.C. §251 does

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<sup>3</sup>

Under 37 CFR §1.111(b), in order to be entitled to reconsideration or further examination, the Applicant must provide a written reply, and that "reply must present arguments pointing out the specific distinctions believed to render the claims ... patentable over the applied references." The Examiners implementation of reissue recapture estoppel in the instant application argues that in 100% of the patents where an Applicant responds to an anticipation rejection, that Applicant's compliance with the express requirement of 37 CFR §1.111(b) forever after estops the Applicant from obtaining allowance of any reissue claim that defines an apparatus that is structurally different from that defined by the patent claim, simply because that reissue claim lacks the "specific distinctions [that were] believed to render the [patent] claims ... patentable over any applied references." This wholesale and blanket estoppel applies even where, as here, the anticipation rejection was frivolous and unwarranted by the prior art. Appellant here is not endeavoring to reargue the anticipation rejection based upon Chapin, because the Examiner has already concurred in the impropriety of that rejection, as is evidenced by the Examiner's withdrawal of that rejection and allowance of all of the patent claims. Moreover, Applicant did not endeavor to narrow the scope of coverage of the patent claims in an effort to avoid Chapin, but simply explained to the Examiner, in compliance with 37 CFR §1.111(b) why Chapin was an improper anticipation reference. Applicant's compliance with the rules of practice can not be said to create a reissue recapture estoppel that prevents Applicant from claiming other inventions disclosed in Applicant's original specification.

not require that reissue claims that may have features that are similar to features of a particular patent claim use the verbatim language of the patent claim to define those feature, together with the fact that the *Pannu* and *Hester Industries* decisions of the Federal Circuit addressed reissue claims that differed only in scope from the patent claims while Appellant's claim 20 is directed to structurally different subject matter than is Appellant's patent claim 7, shows that there is no basis under the doctrine of reissue recapture to sustain the final rejection of reissue claim 20. Such action is respectfully requested.

The Examiner's efforts to misread and ignore the numerous features of patent claim 7 advanced by Appellant and the findings by the Board of more than a single basis<sup>4</sup> for its determination that Bonneau failed to provide a proper vehicle to support an anticipation rejection of patent claim 7 is a *non sequitur* that fails to respond to either those general arguments against anticipation, or to recognize either that the patent claim 7 was found to be novel by the present of more than a single "checking" process, or the fact that rejected reissue claim 20 is directed to a different invention, one that involves a step of "generating" and defines a different invention. The Examiner's crafting of a reissue recapture based upon one argument provided to the Board in order

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<sup>4</sup>

The Examiner fails to recognize that Appellant presented more than one argument to demonstrate a lack of anticipation of patent claim 7 by Bonneau, and that the Board ruled upon the preponderance of evidence rather than a single claim limitation, after finding at least two features of patent claim 7 were not taught by Bonneau. The Examiner's attempt to create a generalization based upon one of those features is a *non sequitur*.

to demonstrate the inadequacy of Bonneau as an anticipation reference will not sustain this rejection. The Board's refusal to sustain the final rejection of claim 20 is therefore, respectfully solicited.

This brief is filed in triplicate. No fee is incurred by this Reply Brief.

Such action is respectfully requested.

Respectfully submitted,



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